

Attorney Docket: 112.P14038

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DEC 04 2006**REMARKS**

Claims 1-5 and 16 are pending in the above-referenced patent application. In this response, claims 1-5 have been amended, claims 6-15 have been cancelled and claim 16 has been added. It is noted that claims were amended and/or cancelled to more clearly delineate intended subject matter. Additionally, support may be found for new claim 16 at least in the specification, figures, and claims as filed.

Claim Rejections – 35 USC 103(a)

In the Final Office Action, the Examiner rejected claims 1, 6 and 11 under 35 U.S.C 103(a) as being unpatentable over Sung (US Patent No. 6,587,231) in view of Matsumoto (US Patent No. 6,147,339); rejected claims 2,7 and 12 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Hu et al. (US Patent No. 6,271,939, hereinafter "Hu"); and rejected claims 3, 5, 8, 10 13 and 15 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Motamed (US Patent No. 6,327,047). These rejections are respectfully traversed. It is noted that claims 6-15 have been cancelled, and, therefore, the rejections of these claims is moot.

Sung v. Matsumoto

Referring now to claim 1, as amended, Assignee respectfully submits that claim 1 is not rendered obvious by the cited art, Sung in view of Matsumoto. It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

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must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, the cited references do not include any suggestion or motivation to combine, and the cited references, if successfully combined, would still not teach or suggest all the claim limitations.

For example, it is respectfully submitted that the combination of Sung and Matsumoto does not show or describe at least "a scanner housing assembly having an integrally formed document-loading panel wherein the scanner housing assembly and integrally formed document-loading panel comprise a transparent acrylic material" as recited in claim 1.

However, Assignee does not by this argument accept that the combination is proper; rather, while Assignee asserts that the combination is improper, Assignee further asserts that even if the combination were proper, and a successful combination of Sung and Matsumoto were made, any resultant combination or any of the other alleged combinations would still not show or describe at least the limitations of claim 1 noted above.

As just an example, the cited portion of Sung (Fig. 1, col.2, lines 35-42) describes two transparent windows (2,3) which form separate parts, not integral with the housing. Sung does not show or describe "a scanner housing assembly having an integrally formed document-loading panel", as recited in claim 1. Furthermore, Matsumoto does not cure this deficiency. Matsumoto is directed toward a hand-held portable scanner that rolls over a document during a scanning procedure. Matsumoto does not teach or suggest "a scanner housing assembly having an integrally formed document-loading panel". Furthermore, the transparent window (18) located at the bottom of the apparatus of Matsumoto does not constitute a document-loading panel, as the portable scanner apparatus of Matsumoto does not hold documents. Therefore, it is respectfully submitted that the cited references, if successfully combined, would still not teach or suggest all the claim limitations. Accordingly, the combination of Sung and Matsumoto does not render claim 1 obvious, and claim 1 is in a condition for allowance.

Sung v. Matsumoto v. Hu

The Examiner has rejected claims 2, 7 and 12 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Hu. It is noted that claims 7 and 12 have been cancelled, and therefore, the rejection of claims 7 and 12 is moot. It is respectfully submitted that Hu does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of claim 2. Hu is directed toward a scanner and a scanner cradle. The scanner of Hu includes removable top and bottom panels coupled to a solid frame of aluminum or plastic. See, for example, col 4:38 – col 4:52. The scanner of Hu does not comprise "a scanner housing assembly having an integrally formed document-loading panel", as recited in claim 1, from which claim 2 depends. Therefore, claim 2 is not rendered obvious by the combination of Sung, Matsumoto and Hu. Accordingly, it is respectfully requested that the Examiner withdraw the rejection to claim 2.

Sung v. Matsumoto v. Motamed

The Examiner has rejected claims 3, 5, 8, 10, 13 and 15 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Motamed. It is noted that claims 8, 10, 13 and 15 have been cancelled, and therefore, the rejection of these claims is moot. It is respectfully submitted that Motamed does not cure the deficiencies of Sung and Matsumoto noted above, and does not show or describe the limitations of the rejected claims. Motamed is directed toward a method of calibrating a scanner. The scanner in Motamed does not comprise "a scanner housing assembly having an integrally formed document-loading panel", as recited in claim 1, from which claims 3 and 5 depend. Therefore, claims 3 and 5 are not rendered obvious by the combination of Sung, Matsumoto and Hu. Accordingly, it is respectfully requested that the Examiner withdraw the rejection to these claims.

Sung v. Matsumoto v. Pan

The Examiner has rejected claims 4, 9 and 14 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Pan and so-called "well known art". It is noted that claims 9 and 14 have been cancelled, and therefore, the rejection of these claims is moot. It is respectfully submitted

that neither of Pan or so-called "well known art" does not cure the deficiencies of Sung and Matsumoto noted above, and, accordingly, the combination of Sung, Matsumoto, Pan and so-called "well known art" does not show or describe the limitations of the rejected claims. Pan is directed toward detecting a scanning object in a scanner. The scanner in Pan does not comprise "a scanner housing assembly having an integrally formed document-loading panel". Additionally, the assertion of what is "well known" is respectfully traversed. In accordance with the Manual for Patent Examining Procedure (MPEP) §2144.03, Assignee respectfully requests that the Examiner either provide documentary evidence of the assertions that these limitations are well known in accordance with MPEP §2144.03, or withdraw the assertion of what is "well known." However, it is respectfully submitted that the combination of Sung, Matsumoto, Pan and so-called "well known art" would still not show or describe "a scanner housing assembly having an integrally formed document-loading panel", as recited in claim 1, from which claim 4 depends. Therefore, claim 4 is not rendered obvious by the combination of Sung, Matsumoto, Pan and what the Examiner alleges is "well known". Accordingly, it is respectfully requested that the Examiner withdraw the rejection to these claims.

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, claims 1-5 and 16 are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that the grounds presented above are sufficient. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims.

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CONCLUSION


In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

12/4/06



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